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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/691,778

10/23/2003

Jerry A. Pickering

10167

7165

7590

10/16/2006

MARK G. BOCCHETTI  
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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/691,778	Applicant(s) PICKERING ET AL. <span style="float: right;">✓</span>	
	Examiner Marc Jimenez	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 1-63,67,68,72-79,82-85 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-66,69-71,80,81,86 and 87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u><del>2-12-04</del> 1-16-04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Species C, Subspecies 13), Claims 64, 65, 66, 69, 71, 80, 81, 86 and 87 in the reply filed on 7-24-06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 69, 70, 86 and 87** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is

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(a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 69 recites the broad recitation “at least about 8 microns”, and the claim also recites “about 25 microns to about 55 microns” which is the narrower statement of the range/limitation. Claim 70 recites the broad recitation “at least about 8 microns”, and the claim also recites “greater than about 55 microns” which is the narrower statement of the range/limitation. Claim 86 recites the broad recitation “at least about 8 microns”, and the claim also recites “about 25 microns to about 55 microns” which is the narrower statement of the range/limitation. Claim 87 recites the broad recitation “at least about 8 microns”, and the claim also recites “about 25 microns to about 55 microns” which is the narrower statement of the range/limitation

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 64-66 and 71** rejected under 35 U.S.C. 102(b) as being anticipated by Eddy et al. (US5729813).

Eddy et al. teach a fuser member comprising a base 6; and a fusing surface layer 2

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7. comprising: a fluoroelastomer (col. 18, line 6); and filler particles (col. 18, line 6), with a modulus greater than the modulus of the fluoroelastomer (Modulus is a measure of stiffness of a given material. The filler is made of alumina which has a modulus greater than a fluoroelastomer which is not as stiff. In addition, the filler imparts hardness to the layer as described in col. 7, lines 52-56, therefore, the filler is harder or stiffer than the fluoroelastomer.) at the fusing temperature, and with a mean particle diameter of at least about 8 microns (col. 7, line 60), in at least the minimum proportion by volume of the fusing surface layer, and with at least the minimum mean particle diameter. Regarding the limitations “so that, in fusing toner to substrate, the fuser member generates an image having a gloss number of about 5 or less” and “in fusing toner to substrate, the fuser member, at the equilibrium surface roughness, generates an image having a gloss number of about 5 or less”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The filler particles are heat conducting and have a greater thermal conductivity than the fluoroelastomer because the filler is made of alumina. In addition, alumina is considered inorganic.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 69, 70, 86 and 87** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al.

Eddy et al. teach the invention cited above with the exception of having a mean particle diameter from about 25 microns to about 55 microns as recited in claim 69 or a mean particle diameter greater than about 55 microns as recited in claim 70.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used a mean particle diameter from about 25 microns to about 55 microns as recited in claim 69 or a mean particle diameter greater than about 55 microns as recited in claim 70 because applicant has not disclosed that a mean particle diameter from about 25 microns to about 55 as recited in claim 69 or a mean particle diameter greater than about 55 microns as recited in claim 70 provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the mean particle diameter taught by Eddy et al. or the claimed mean particle diameter because either particle diameter perform the same function of providing conductivity equally well. In addition, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to modify the particle size depending upon the desired conductivity needed for the roll.

10. **Claims 80-81** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al. in view of Donnelley et al. (US3669707).

Eddy et al. teach the invention cited above with the exception of using plastic filler particles such as polytetrafluoroethylene.

Donnelley et al. teach using plastic filler particles such as polytetrafluoroethylene (col. 4, line 66).

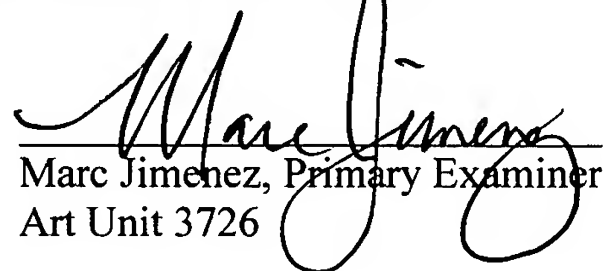
It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Eddy et al. with plastic filler particles such as polytetrafluoroethylene, in light of the teachings of Donnelley et al., in order to reduce offset and mechanical breakdown as suggested by Donnelley et al.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Marc Jimenez, Primary Examiner  
Art Unit 3726

MJ  
9-19-06